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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,342	03/12/2004	Dwight Allen Merriman	11032/3067	5601
23838 7590 02/28/2008 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
EXAMINER LANEAU, RONALD				
ART UNIT 3714		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/798,342

**Applicant(s)**

MERRIMAN ET AL.

**Examiner**

RONALD LANEAU

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/26/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 01132005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Prosecution reopened***

1. In view of the comments made by the Board of Patent Appeals and Interferences regarding the scope of claim 1 which must be given the broadest reasonable interpretation, prosecution is HEREBY reopened.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-7 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 2-7 are directed to the content of the stored information, which constitutes non-functional descriptive material. These recitations are not functionally involved in the steps recited in claim 1. The providing steps would be performed the same regardless of the stored information. Thus, it is not clear why any weight should be given to the content of the stored information as recited. As a result, claims 2-7 will not be examined and must be canceled.

***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 01/13/05 has been entered and considered by the examiner.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-15 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler (US 5,960,409) in view of Goldhaber et al (US 5,794,210).

As per claims 1 and 9, Wexler teaches a method for advertising, comprising: receiving an advertisement request 11a from a user node 3, wherein said advertisement request is based upon a link 7 sent from an affiliate node 13 to said user node 3 in response to a content request 15a sent from said user node 3 to said affiliate node 13 (col. 4, lines 28-40 and 54-57). Wexler does not explicitly disclose the selecting an advertisement based on stored information but Goldhaber discloses selecting, in response to said advertisement request, an advertisement based upon stored information about said user node (col. 14, lines 17-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the selecting step as disclosed by Goldhaber into the method of Wexler because it would allow the advertisers to target their advertisements to a subset of the general population that may be more likely to respond to the advertisements and also assure that its advertising is delivered to the consumers most likely to purchase its products.

As per claims 2-7, the limitations of “content of the stored information” has no weight since they are non-functional descriptive material. They are however rejected under the combination of Wexler and Goldhaber (see claim 1).

As per claim 8, the combination of Wexler and Goldhaber would disclose a method wherein selecting an advertisement is further based upon an operating system type, each associated with said user node as claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the same reasons given in claim 1.

As per claims 10-14, Goldhaber discloses a system wherein if selection criteria associated with more than one advertisement are satisfied based upon said stored information, then calculating a satisfaction index for each advertisement (see fig. 11A, 182), and selecting the advertisement with the lowest satisfaction index, wherein said satisfaction index for an advertisement is directly proportional to the number of times said advertisement is sent to a user node, wherein said satisfaction index for an advertisement is inversely proportional to the amount of time expired since said advertisement was first permitted to be sent to a user node (see Goldhaber, fig. 11A, scanning for matching ads and screening for used ads), wherein said satisfaction index for an advertisement is inversely proportional to the maximum number of times the advertisement is permitted to be sent to a user node, wherein said satisfaction index for an advertisement is directly proportional to the total amount of time over which said advertisement is permitted to be sent (see Goldhaber, fig. 11A, by indexing each ad, the system is actually counting the number of times this ad has been sent to a user node as claimed).

As per claim 15, Wexler discloses a method wherein an advertisement request would include an Internet Protocol address associated with a user node as claimed (see fig. 2).

As per claim 19, Goldhaber teaches a system further comprising sending said selected advertisement to said user node for display (col. 18, lines 57-69).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the advertisement selection for display as taught by Goldhaber into the method of Wexler because it would allow the system to monitor the user's activities and record the interests of the user based on time spending looking at the ad.

As per claims 20-22, the combination of Wexler and Goldhaber would disclose a system comprising receiving from said user node a click through request for information about the advertiser associated with said selected advertisement, further comprising sending a network address for said advertiser to said user node in response to said click-through request, wherein said stored information includes information about a prior click-through request received from said user node (see Wexler, col. 3, line 65 to col. 4, lines 9, see abstract; see Goldhaber for the selection step).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Wexler and Goldhaber for the same reasons discussed previously.

6. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler (US 5,960,409) in view of Goldhaber et al (US 5,794,210) and further in view of Funk et al (US 5,937,162).

As per claims 16-18, neither Wexler nor Goldhaber discloses a system for performing a reverse domain and for selecting an advertisement based on the results of said reverse domain but Funk discloses a system performing a reverse domain lookup table based upon an internet protocol address, selecting an advertisement based upon the results of said reverse domain and

perform a trace operation route (see claim 1; reverse domain is querying a domain name server (DNS) to determine the corresponding domain name).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the selecting step as disclosed by Goldhaber into the method of Wexler because it would allow the advertisers to target their advertisements to a subset of the general population that may be more likely to respond to the advertisements and also assure that its advertising is delivered to the consumers most likely to purchase its products. It would have been obvious to one of ordinary skill in the art to utilize the domain name querying system as taught by Funk into the combined systems of Wexler and Goldhaber because it would provide a system that can send a unique, customized advertisement to a group of selected users and allow them to click and see the ad on the display screen.

#### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication should be directed to RONALD LANEAU at telephone number (571)272-6784.

Art Unit: 3714

Ronald Lancau  
SPE  
Art Unit 3714

/Ronald Lancau/

Supervisory Patent Examiner, Art Unit 3714

02/25/08